

REMARKS

Applicant's undersigned attorney thanks the examiner for his time and comments during the June 6, 2006, phone conversation regarding the above-identified application.

Applicant is presenting for the examiner's convenience the claim amendments presented in applicant's February 22, 2006, Amendment in Reply.

Responding to applicant's February 22, 2006, Amendment in Reply, the examiner stated in the Notice of Non-Compliant Amendment (37 CFR 1.121):

Newly submitted claim language directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 4-6, 8-13 and 16-86 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant's amendment has added to the claims several non-elected species elements into the claim structure. Claims should be drawn to the elected species for continued prosecution of this application. For example, proposed claim 1 now attempt to change language from a structure of the lead frame of figure 1 to the lead frame of figure 4. Applicant's proposed amended claim 1 now attempt to at the least add species II and species IX.

Applicant respectfully disagrees that the amendments presented in the February 22, 2006, Amendment in Reply are non-compliant amendments.

Applicant elected, in the October 3, 2005, Response to Restriction/Election Requirement, Species I, corresponding to claim 3. Subsequently, in its February 22, 2006, Amendment in Reply, applicant amended the claims to include the features of elected claim 3 in independent claim 1.

Thus, pending independent claim 1, in its amended form, is still directed to the subject matter of elected Species I. All applicant has done in it February 22, 2006, Amendment in Reply, is further narrow the scope of the claim pertaining to elected Species I by including further limitations in addition to the limitation of Species I.

Had applicant removed the limitations of its previously elected invention and presented for examination claims directed to non-elected claims (and thus non-elected Species), then arguably the guidelines enunciated by MPEP 821.03 could have been used to prevent applicant from doing so. But applicant did not remove the recited limitations of the previously elected Species. Rather, applicant's merely added to those limitations.

Applicant notes that 37 C.F.R. §1.111(a)(1) states:

37 CFR 1.111 Reply by applicant or patent owner to a non-final Office action.

(a) (1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment.

MPEP 714.02 then explains, with respect to the provisions of 37 C.F.R. §1.111:

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 37 CFR 1.121(c). The requirements of 37 CFR 1.111(b) must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

Thus, both 37 C.F.R. §1.111 and the MPEP's explanation of the rule establish the applicant's right to amend the claims in response to an examiner's office action, so long that such amendments comply with the requirements set forth in 37 C.F.R. §1.121(c). As examiner knows, 37 C.F.R. §1.121(c) governs the form of the amendments, and does not itself impose any restrictions on what subject matter may be included in the amendments. In other words, applicant always retains the right to add further limitations to a previously presented claim, which is what applicant has done in its February 22, 2006, Amendment in Reply.

Applicant would further like to point out that limitations that have not been previously recited in any claim, but are otherwise disclosed in the Specification, are regularly added to one claim or another in the ordinary course of prosecution. Surely then, if an applicant is entitled to add to a claim limitation not previously recited in any claim, he should also be entitled to add such a limitation even if that limitation happens to have been recited in non-elected claim.

In view of the foregoing, applicant considers that its February 22, 2006, Amendment in Reply, is compliant with rule 37 C.F.R. §1.121, and asks that the examiner's request as stated in the Notice of Non-Compliant Amendment (37 CFR 1.121) be withdrawn.

Additionally, the examiner noted that applicant's proposed amended claim 1 would still be rejected by at least figure 4 of U.S. Patent No. 6,066,861 to Hohn.

Applicant respectfully disagrees.

Independent claim 1, in its amended form recites "a molding material encasing said leadframe and said radiation-emitting chip and having a shape defining a mounting surface of the component, said mounting surface extending at a first predetermined angle having a value lying within a range from 0° to 20° relative to a main emission direction of the component." As explained in applicant's February 22, 2006, Amendment in Reply, the mounting surface of applicant's component is substantially parallel to the emission direction of the component, or slightly skewed (up to 20 degrees) with respect to the main emission direction. This design facilitates sideways illumination of the target surface on which applicant's component is mounted.

In contrast, Hohn is silent, with respect to FIG. 4, as to which of the component's surfaces is the mounting surface. However, Hohn's FIG. 4 suggests that the main emission direction is through the curved surface (i.e., the top surface appearing in FIG. 4), and that the mounting surface is the bottom surface, or base, of the component. Thus, FIG. 4 suggests that the mounting surface is perpendicular to the main emission direction of the component, and therefore Hohn does not disclose or suggest at least the feature of "said mounting surface extending at a first predetermined angle having a value lying within a range from 0° to 20° relative to a main emission direction of the component," as required by applicant's amended independent claim 1. Claim 1 and the claims that depend from it are therefore patentable over the Hohn reference.

It is believed that all the rejections and/or objections raised by the examiner have been addressed.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

Enclosed is a Petition for One Month Extension of Time. The fees in the amount of \$120 are being paid concurrently on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other required fees to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,

Date:

June 28, 2006

Ido Rabinovitch
Ido Rabinovitch
Reg. No. L0080

PTO Customer No. 26161
Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (617) 542-8906